

## REMARKS

In Paragraph 4 of the last Office Action, the examiner has objected to the specification amendment of 16 April 2004, relating to cards having a thickness of less than about ¼ inch or less than 0.05 inch.

The attention of the examiner is directed to claim 16 as originally filed in this application, in which it is stated that the card has a thickness of less than about ¼ inch. Also the attention of the examiner is directed to originally filed claim 2, in which the card is stated to have a thickness of "...less than about 0.05 inches..."

Accordingly, it is believed that the added amendment referred to by the examiner is properly supported.

It is also believed that the presence of the "0.05 inches" limitation found in claim 2, and also claim 9 as originally filed, addresses and renders moot the rejection of claims 2, 9, 25 and 30 under 35 U.S.C. 112 (Section 7 of the latest Office Action). However, claim 30 has been cancelled per section 5 of the office action.

The examiner has rejected claims 5, 12 and 27 under 35 U.S.C. 112. They have been amended to overcome the rejection.

The examiner has rejected independent claims 1, 8 and 24 under 35 U.S.C. 101 as comprising non-statutory subject matter.

As the examiner states: "The above claims do not clearly indicate what would happen *if there is not a match* between two biometric identification data (e.g., if the smart card is used by a player other than the owner of the smart card, whose biometric data is stored on the card.) Therefore, the results of the above claims are conditional and are not guaranteed to be reproduced every time."

It is submitted that there is no requirement for results of a claim to be produced every time. This is intrinsic in the claims by the language "if there is a match". It is not seen that there is any requirement to state what happens in the claim if there is a mismatch. The invention of this application may be utilized, whether or not a signal is given, or simply nothing happens in the case of a mismatch.

Accordingly, it is submitted that the independent claims are in compliance with 35 U.S.C. 101.

The examiner has rejected claims 1, 6, 8, 12-13, 24, 26, and 28-29 as unpatentable over Orus et al. U.S. Publication 2004/0035926 A1 in view of Soltesz et al. U.S. Publication 2001/0011680 A1.

Orus et al. discloses a method for monitoring the transfer of value units in a chip card gambling system. The card is carried by the gambler, and cash can be transferred between the card and a plurality of gambling machines. As described in paragraphs 0063 and 0091, numerical card identification numbers and balance values stored in the card are compared with a database to certify the data exchanged and to check the integrity of the system.

As stated in paragraph 92, "...a security module calculates an authentication certificate from secret data stored in the memory of the module and the monitoring means check that the authentication certificate calculated by the security module corresponds to the authentication certificate calculated by the gambling card or by another security module."

Thus, security in the card system of Orus et al. is an entirely numerical system shown in detail in Fig. 2, etc. and the related text of the specification.

As the examiner acknowledges, Orus et al. does not teach a biometric smart card that stores biometric data for the player, or a reader which receives the biometric data stored on the smart card; or a biometric measurement device for measuring biometric data of a user to provide measured biometric data, or the comparator for comparing the measured biometric data to the biometric data stored on the smart card, or the step of outputting an authorization allowing the player to access his or her account if there is a match. None of these elements are taught.

Turning to Soltesz et al., a self-service kiosk is described which is used, as described in its paragraph 0003, as an Automated Teller Machine, or for other types of vending machines, or internet or telephone system access. However, there is no teaching in Soltesz of the use of its system with gaming machines. Rather, it is used only for machines where an exact, expected service or product is provided to the user. In the functions described in paragraph 0003, the user of a kiosk knows what the outcome will be. He expects to receive a precise amount of cash, an airline ticket, a telephone call or the like, contrary to the present invention. There would be quite a fuss if he failed to receive it. There is no suggestion of using the Soltesz et al. system with gaming machines where the outcome may be winning, or losing so that nothing is provided to the player, or a variable award. Thus, unlike the functions described in paragraph 0003 of Soltesz et al., the player in the present invention does not control the outcome.

Beginning on the last paragraph of page 9 of the latest Office Action, the examiner states that it would be obvious to modify Orus et al. by the teaching of Soltesz, because the elements of Soltesz "...would provide both convenience and

security for the player to use his smart card to play different games at different gaming machines (e.g., in a casino) using the same card and the same account cash/token balance on the card. This enables the player to walk around in the casino cash-free without risk using his cash or having to carry lots of coins around. Storing users of biometric data (e.g., fingerprint) on the user's card would prevent unauthorized use of the card should the card be stolen or lost and recovered by another player."

However, the above is the invention of applicant, and not the invention of Soltesz et al. or Orus et al. Soltesz et al. makes no mention of use of his system in the gaming apparatus area. From the perspective of Orus et al., the method used therein is already "secured" (see the title of the patent). Those skilled in the art, having Orus et al. before them, are presented with a numerical security system for protection. Why should further protection be sought, but for the hindsight provided by this present disclosure?

There is no hint in either of the two cited references that there would be a desirability to combine the two systems in a manner not specified by either Orus et al. or Soltesz et al., to come up with the system and method claimed in the present application.

As stated in MPEP Section 2142:

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure."

There is no reason found in the teachings of either Orus et al. or Soltesz et al. why the combination raised by the Examiner would be obvious to those skilled in the art.

Rather, it is the disclosure of this present application that has inspired the Examiner to make this combination. Thus, it is submitted that the rejection based on the combination of Orus et al. in view of Soltesz et al. should be withdrawn.

Furthermore, note that Orus et al. in paragraph 0018 calls for a central processing unit that "...has a database that in parallel stores the data representing gambling operations carried out, particularly card identification data and data representing the balances of value units debited and/or credited..."

This parallel storing of card identification data teaches away from the concept of Soltesz et al. in which the biometric card identification data is not stored in the kiosk, but rather is only stored on the card. Thus, those skilled in the art would not be led to combine the references.

Further with regard to the above rejection respecting claim 8, claim 8 calls for the further step of "storing personal preference data for said player in said smart card". Neither of the cited references teach or render obvious the step of storing such personal preference data for the player in the smart card. Claim 24 also calls for the debit card to store personal preference data for the first user. This personal preference data concept is found at page 6, lines 4-8 of the specification, in which the smart card "can be used for storing user preference information such as indication of types of games, drinks, entertainment and the like preferred, food, smoking/non-smoking preferences, preferred machine denominations and the like."

Neither Orus et al. or Soltesz et al. teach such a smart card that includes stored personal preference information pertinent to the field of gaming. As such, it is submitted

that claims 8, 24, and their dependent claims are patentable on this separate ground as well.

The Examiner has rejected claims 2-3, 5, 9-10, 27 and 30 under 35 U.S.C. §103(a) as unpatentable over Orus et al. in view of Soltesz et al. and further in view of Thompson, U.S. Patent No. 5,865,470.

These claims share in the patentable limitations from which they depend and, as such, are submitted to be patentable.

The Examiner has rejected claim 25 as unpatentable over Nakata et al., U.S. Patent No. 5,736,727. Claim 25 depends from claim 24, and thus shares in the patentable limitations thereof.

In view of the above, allowance of the claims is respectfully requested.

Respectfully submitted,

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